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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/056,898      | 01/25/2002  | Horst Heckmann       | B87.312-26          | 3283             |

164            7590            03/10/2003  
**KINNEY & LANGE, P.A.**  
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**312 SOUTH THIRD STREET**  
**MINNEAPOLIS, MN 55415-1002**

EXAMINER

CULBRETH, ERIC D

ART UNIT

PAPER NUMBER

3616

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/056,898             | HECKMANN, HORST     |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Eric D Culbreth        | 3616                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 December 2002.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 7-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 7-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 19 December 2002 is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because reference numeral 11 does not appear to point to a pump in the drawings (see page 3, line 30). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
  
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 12/19/2002 have been disapproved because the lead line for reference numeral 11 in the proposed drawings still does not refer to a pump, but rather to a mast. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
  
4. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckmann (US Patent 5,638,967, cited by applicant) in view of Japanese Patent 5-178171. Heckmann discloses a vehicle for delivering concrete to an elevated location (column 1, lines 10-25), the vehicle having opposing long sides, a front and a back in Figure 1. Heckmann

further teaches in column 3, line 61 – column 4, line 17 a concrete pump, feeding hopper, a swiveling mast (abstract), slewing gear 11, and a frame support 18. The frame support has four beams 19-22 and free end supports 23-26. As seen in Figure 1, movable telescopes 19-22 are on both sides of the vehicle and extend front to back to stabilize the vehicle when the mast is extended. Hollow support sections 37 on each side of the vehicle are a pair of common carriers providing stationary telescopes disposed at least partly in an arc (i.e., on the sides next to the mast) tangentially to a longitudinal direction of the vehicle. The stationary telescopes or guides 31-34 extend from one of the long sides of the vehicle inward as far as a middle (at least) and then outward to the same long side. Each telescope also cooperates with one of the movable telescopes to allow it to move outward from the corresponding side of the vehicle, emerging from associated front and back ends of the carrier. However, Heckmann does not teach the common carrier disposing the front and back movable telescopes and the cooperating stationary telescopes one behind the other. Japanese '171 discloses a carrier 12 that stores beams 11 with their ends adjacent so that the free ends with support member 13 emerge from the carrier 12 at its ends. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heckmann to include a carrier that stores the beams with their ends adjacent in order to store the beams for transport using an alternative arrangement to the various alternative equivalent arrangements already shown in Heckmann's Figures 1-2 and 3-4 and in view of Heckmann's teaching at column 5, lines 1-5 that different embodiment examples can be used as long as the front frame support has arcuate guides with arcuate beams (claim 1). In the combination the movable telescopes would be arranged front to back in keeping with Heckmann's longitudinally extending carriers and telescopes (claim 1), and the movable and

stationary telescopes would be congruent (i.e., they correspond or conform to each other in shape) (claim 2).

Regarding claims 3-4, in the combination, the stationary telescopes of the common carriers are congruent as broadly recited (i.e., they correspond in shape or radius of arc in Heckmann on each side of the vehicle in that they are mirror images).

Regarding claim 5, Heckmann teaches making the shape or curvatures of the carriers correspond to the curvature of the telescope, and making the movable telescopes with different curvatures would be an obvious matter of design choice, as the invention would appear to work just as well with the movable telescopes having different curvatures as having the same curvatures, and as even Heckmann teaches at column 5, lines 60-63 that the beams do not have to have an exactly arcuate form.

Regarding claims 7-10, in the combination Heckmann teaches the stationary telescopes 31-34 on both sides being congruent as broadly recited (i.e., having the same arc or curvature), and this would be a teaching in the combination to make the stationary telescopes on both sides receiving two movable telescopes each of the same curvature.

#### *Response to Arguments*

5. The arguments filed 12/19/02 have been carefully considered but deemed not persuasive in overcoming the rejection.

In response to applicant's argument that there is no suggestion to combine the references (pages 7-8 of the remarks), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where

there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as noted above Heckmann, the primary reference, teaches at column 5, lines 1-5 that the embodiments disclosed are examples only having in common that the front beams and guides are curved. This disclosure in the primary reference would lead the skilled artisan to consider other examples of embodiments from the art such as Japanese '171's, so long as at least the front beams and guides are curved as already taught by Heckmann.

Further noting the citing on page 8 of the remarks that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination", as just noted Heckmann suggests other arrangements of the beams so long as the front beams are curved at column 5, lines 1-5.

Contrary to applicant's remarks on page 8, the first Office Action did not suggest the motivation to combine the references came from Japanese '171, but rather from Heckmann's use of alternative embodiments – a motivation which is being maintained with this Action.

Regarding the confusion over "stabilizing extensions" of Japanese '171 (see pages 8-9 of the 12/19/02 remarks), the applicant is reminded that the issues over the term "stabilizing extensions" arose in parent application 09/692,062 because the applicant introduced the term into those claims and asserted that the term defined over Japanese '171, and the examiner argued at that time that this was new matter because the stationary telescopes of the parent application had not been originally disclosed in a manner that defined over Japanese '171's telescoping

extensions. The same still applies; whether Japanese '171's members 11 are called "stabilizing extensions", "telescoping members", etc., they are analogous to applicant's members 14-17 and hence are a teaching in the combination in addition to Heckmann's disclosure at column 5 that the embodiments disclosed are examples of arrangements that only have to have curved front beams.

In response to applicant's argument that Japanese '171 is not suitable for a vehicle with a concrete pump (page 9 of the remarks) and the Japanese '171 has only three legs (page 10 of the remarks), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Similarly, in response to applicant's arguments against the references individually (i.e., that Japanese '171 teaches "destabilizing extensions" on page 10), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Japanese '171 telescopes for adjustability (page 10 of the remarks), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). At any rate, in the combination it would be desirable to make the

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telescoping legs of Heckmann adjustable so the vehicle when working could fit in various spaces; this is another teaching to combine the references.

On page 10-11 of the remarks, the applicant argues that it would not be obvious to form the telescopes with different curvatures. This is not persuasive because, as noted above, Heckmann already teaches (column 5, lines 60-62) that the telescoping beams do not have to be exactly arcuate, which would include different curvatures, and as also noted above, the fact that applicant has recognized an advantage which would flow naturally from following the suggestion of the prior art (i.e., to permit different spans and thus a better adaptation of the frame support to the mast tilt) cannot be the basis for patentability.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D Culbreth whose telephone number is 703/308-0360. The examiner can normally be reached on Monday-Thursday, 9:30-7:00 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 703-308-2089. The fax phone numbers for the organization where this application or proceeding is assigned are 703/746-3508 for regular communications and 703/308-2571 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Eric D Culbreth  
Primary Examiner  
Art Unit 3616

*Eric Culbreth*

*3/7/03*

ec

March 7, 2003